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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/692,749	10/20/00	DECOSTER S	05725.0782-0

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EXAMINER	
YU, G	
ART UNIT	PAPER NUMBER
1619	5

DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/692,749	DECOSTER ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-108* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. See spec. p. 5, lines 22-24; p. 12, lines 17-20; p. 14, lines 17-18; p. 15, lines 8-15. Applicant is required to amend the disclosure to include the material incorporated by reference, or state for the record that the incorporated material is not essential. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-108 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 96, 105, 106, and 108 are rejected because the metes and bounds of "group that can react by chain addition reaction" and the term "can optionally further comprise" are unclear, rendering the claims vague and indefinite.

Claim 12 is rejected because the term "essentially" is relative or subjective, rendering the claim vague and indefinite.

Claim 23 is rejected because the claim contains an alternative expression "chosen from", while the claim specifies its limitation to "decamethyltetrasiloxane". The claim is vague and indefinite.

Claim 27 is rejected because the it is unclear whether the use of "/" symbol indicates "and" or "or, which renders the claim vague and confusing.

Claim 101 is rejected because the term "satisfactory" is relative or subjective, rendering the claim vague and indefinite.

Claim 105 is rejected because the term "caring" is vague and indefinite because the metes and bounds of the patent protection sought are unclear.

The depending claims of the above mentioned claims are also rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(A) Claims 1-31, 38 – 40, 94-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017 A2) in view of Dubief et al. (U.S. Pat. No. 5,650,383).

Dalle et al. teach a method of making silicone in water emulsions comprising at least one polysiloxane identical to formula (I) in claim 1 and at least one surfactant among anionic,

nonionic, amphoteric, and cationic surfactants. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13-14 in the instant application. See Examples 1-3 on p. 6. The particle size of the silicone copolymer is also in the range of 0.3 – 100 μm, which meets claims 15-16. See p. 5, lines 35-41. Formulating the composition with additives including perfume, polymers and moisturizing agents is disclosed, meeting claims 94. See p. 4, line 57- p. 5, line 1; p. 6, lines 2- 4. The use of the composition in hair or skin washing of treatment applications is also disclosed, which meets claims 96 - 108. See p. 5, lines 47 – 57. The reference fails to teach using additional silicone described in the instant claims 15-40.

Dubief et al. ('383) teach composition for washing and rinsing hair, which comprise water-insoluble silicone in an aqueous medium and surfactants. The polyorganosiloxanes in claims -15 – 31and 38 are disclosed in col. 2, line 66 – col. 6, line 8. The use of the silicone in the amount of 0.1 – 30% by weight is also disclosed, which meets claims 39 and 40, col. 6 lines 5 – 9. The reference teaches that the disclosed silicones had been used in hair composition art and contribute to shine, softness, lightness on hair and easy management. See col. 1, line 21 – 24. The invention discloses that a hair care composition comprising the above mentioned polyorganosiloxanes and amphoteric polymers diallyldialkylammonium and from an anionic acrylic monomer enhances disentanglment. See col. 1, lines 31 – 43. One would have been able to optimize the weight percent of the additives in the composition through routine experiments.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Dalle et al. by adding an additional silicone disclosed in Dubief et al., because of the expectation to have successfully produced hair care composition that enhances shine, softness, lightness and disentanglment of hair.

(B) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Dubief et al., ('383) as applied to claims 1-31, 38-40, 94-108 above, and further in view of Grollier et al. (U.S. Pat. No. 5,063,051).

Dalle et al. and Dubief et al. ('383) are discussed above. The combined references fail to teach the polysiloxane in claim 32.

Grollier et al. ('051) disclose a cosmetic hair treatment composition comprising a polyorganosiloxane containing a hydroalkyl functional group of formula (IX) of the instant claim 32 and its constituents. See abstract. The reference teaches that the composition, in its application on hair, enhances shine, lightness, and volume. See col. 1, lines 22 – 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified the composition of the combined references by adding the polyorganosiloxane of formula (IX) because of the expectation to have successfully produced a hair treatment composition that provides shine, lightness, and volume to the hair.

(C) Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Dubief et al. ('383), Grollier et al. ('051) as applied to claims 1-32, 38-40, 94-108 above, and further in view of Grollier et al. (U.S. Pat. No. 4,957,732).

Dalle et al., Dubief et al. ('383), Grollier et al. ('732) are discussed above. The combined references lack the teaching of using the polyorganosiloxane of claim 33.

Grollier et al. ('732) describe shaving composition comprising polyorgano-siloxane of formula (X) and in claim 33 and its constituents. See col. 1, line 54 – col. 2, line 25. The reference teaches that the use of the polyorganosiloxanes in the invention exhibited substantial

improvement to be obtained in the smoothness and softness of these compositions, preserves the quality and stability of the composition while emptying from aerosol container, and easy rinsing of hair with water, and leaving skin clean and satiny. See col. 1, lines 28 – 45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the polyorganosiloxane disclosed in Grollier et al. ('732) because of the expectation to have successfully produced an aerosol hair care or shaving composition that is smooth in feel and easy to rinse, retains the quality and stability while being dispensed from the container, and leaves the skin clean and satiny.

(D) Claim 34 - 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Dubief et al. ('383), Grollier et al. ('051) and ('732) as applied to claims 1-33, 38-40, and 94-108 above, and further in view of Dubief et al. (U.S. Pat. No. 6,011,126).

Dubief et al. ('126) disclose a cosmetic composition for hair treatment, which comprises a polymer grafted with a non-silicone organic skeleton grafted with polysiloxane monomers, or polysiloxane polymer grafted with a non-silicone organic monomers, which meets claims 34 and 35. See abstract. The polysiloxane macromers of formula (X) in the instant claim 36 is disclosed in col. 4, lines 16 – 33. Claim 37 is rejected by the disclosure in col. 6, line 66 – col. 7, line 8. The reference teaches that the use of these polymers in hair product enhances the styling properties, col. 1, lines 30 - 40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the grafted

polysiloxane polymer in Dubief et al. ('126) because of the expectation to have successfully produced a hair care composition with enhanced hair styling properties.

(E) Claims 41 – 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Dubief et al. ('383), ('126), Grollier et al. ('051) and ('732) as applied to claims 1-40, and 94-108 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

Dalle et al., Dubief et al. ('383), ('126), and Grollier et al. ('051) ('732) are discussed above. The combined references lack the teaching of using the cationic polymers in claims 41-67.

Restle et al. teach an oil-in-water emulsion comprising a silicone surfactant and at least one cationic amphiphilic lipid which is a quaternary ammonium salt of formulas (IV) – (VII) and their constituents in the instant claims 41 - 67. See col. 2, line 59 –col. 6, line 38. Using 1-60% of the cationic amphiphilic lipids by weight is also disclosed, which meets claims 65 – 67. See col. 6, lines 42 – 50. The reference teaches that the composition, when used in hair treatment products, renders the hair softness and gloss without a greasy feel or appearance, and disentangles easily. See col. 1, lines 24 – 48.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the cationic surfactants containing the quaternary ammonium salt, as taught by Restle et al., because of the expectation to have successfully produced a hair care composition which leaves the hair soft and gloss with no greasy feel or appearances and disentangles the hair easily.

(G) Claims 68-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., Dubief et al. ('383), ('126), Grollier et al. ('051), ('732), and Restle et al., as applied to claims 1-67 and 94-108 above, and further in view of Inman (U.S. Pat. No. 5,948,739).

Inman describes aqueous hair conditioning shampoo compositions, containing silicone conditioning agent and a detersive surfactant component which is a combination of anionic surfactant and amphoteric, zwitterionic, or other non-ionic surfactants. See col. 2, lines 31 – 61; col. 3, lines 1 – 17. The anionic surfactants of instant claims 68 – 79 are disclosed in col. 4, line 11 – col. 6, line 14. The nonionic surfactants of claims 70-83 are described in col. 6, line 14 - col. 8, line 44. The amphoteric surfactants of claims 84 – 88 and 91 – 93 are described in col. 8, line 46 - col. 11, line 20. Claims 89 – 91 are met by the disclosure in col. 11, lines 21 – 28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the surfactants as taught by Inman because of the expectation to have successfully produced a hair conditioning shampoo composition with a good cleaning property.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 and 41-104 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-83 of copending application no. 09/692360; claims 1-95 of copending application no. 09/692155; claims 1-16, 37-104 of copending application no. 09/692716. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is directed to hair care composition comprising silicone copolymers, cationic surfactants, and additional surfactants of identical formulas.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 29, 2001

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